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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,737

Applicant(s)

LOPEZ ET AL.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 20-35 and 51-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 20-35 and 51-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Response To Applicant's Amendments

The Examiner approves the changes made to the claimed invention. However, the newly added claims 51-71 were renumbered 51-68 because of an inconsistency in the numbering sequence since claim 65 rather than claim 68 follows claim 64. If applicants intend to add additional claims they should begin with claim number 69 (See CFR 1.126). By so doing, the dependency of dependent claims 66-68 is now claim 65, as opposed to claim 68 as reported in the current amendment.

DETAILED ACTION

Specification

Status of the claims

After a restriction requirement, Applicant had elected, over the phone and without traverse, to have claims 1-16 and 20-35 prosecuted on the merits. After the First Office Action, claims 51-68 were added. Hence, claims 1-16, 20-35 and 51-68 are currently pending and claims 17-19 and 36-50 are canceled.

Claim Objections

Claims 1 and 20 (including subsequent dependent claims) are objected to because of the following informalities:

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Concerning claims 1 and 20 (including subsequent dependent claims), “wherein said at least negotiable economic credit comprises at least one of the following: at least one coupon, at least one financial award, at least one financial incentive or cash” should apparently be --wherein said at least **one** negotiable economic credit comprises at least one of the following: at least one coupon, at least one financial award, at least one financial incentive or cash--.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 8-11, 13, 20-32, 34-35, 57, 61-62, 63 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Guthrie et al. (hereinafter Guthrie), US Patent 6,467,686 B1.

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As per claim 1, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any other computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle. The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7) located at the checkout used to upload or transfer the coupon data from the coupon scanner to the retail store system during a redemption process (synchronization of POS and handheld device) (Col. 4: 64 to col. 5: 24).

As per claims 2, 4 and 62, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any other computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle (docking station 22 of figs. 1, 6 and 7). The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a retail store where he can redeem at least one electronic coupon at the retail store checkout having a POS cradle

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located at the checkout used to connect the coupon scanner in order upload or transfer the at least one electronic coupon data from the coupon scanner to the retail store system (synchronization of POS and handheld device) (Col. 4: 64 to col. 5: 24; col. 7: 48 to col. 8: 24; col. 8: 66 to col. 9: 34).

As per claims 3 and 5, Guthrie teaches a system wherein after redeeming at least one electronic coupon stored within the memory or database of the coupon scanner, subsequent to uploading during a redemption process or synchronization process the at least one electronic coupon data from the coupon scanner to the retail store POS system (pricing system) and successfully comparing and matching transmitted coupon data with scannable pricing information, coupon information related to the redeemed electronic coupon is deleted from the memory or database of the coupon scanner where the coupon information was stored to thereby prevent fraud (reconciling data representative of the at least one electronic coupon or negotiable economic credit stored within the memory or database of the coupon scanner or handheld device) (col. 8: 66 to col. 9: 34).

As per claims 8-11, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle (docking station 22 of figs. 1, 6 and 7). The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data

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with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a retail store where he can redeem at least one electronic coupon at the retail store checkout having a POS cradle (docking station) located at the checkout used to connect the coupon scanner in order to upload or transfer the at least one electronic coupon data from the coupon scanner or handheld device to the retail store system (synchronization of POS and handheld device). And when a product UPC code, stored in a database or product database related to the retail store POS system and read by the retail store POS scanner during a transaction or redemption process, matches a product UPC code in the customer's or user's order, which is directly associated with the at least one electronic coupon transferred from the user's coupon scanner or handheld device to the retail store POS system and when the uploaded or transferred electronic coupon information and the validation code respectively compared to the scannable pricing information stored in the POS pricing database (coupon database) and the stored validation code to a corresponding validation code provided by a manufacturer match the scannable pricing information and the provided validation code respectively, the at least one electronic coupon is redeemed accordingly and a price reduction is applied to the customer's order (It is further understood here that coupon data are stored in a database or pricing database or coupon database coupled to the POS system and wherein the stored data are retrieved during redemption and used for validation and comparison purposes as inherently practiced in the art).

(Col. 7: 48 to col. 9: 34) and (Col. 4: 64 to col. 5: 24; col. 7: 48 to col. 8: 24; col. 8: 66 to col. 9: 34; col. 12: 56-62; fig. 9; see also claim 1 of the prior art).

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As per claims 13, 25-26, 32, 34-35, 57, 61, 63 and 65, Guthrie discloses a system for providing electronic coupons (new coupon data) or negotiable economic credits to a user over the Internet or any computer network having a server containing a central repository or database (coupon source) storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle during an interaction or synchronization between the central repository and the coupon scanner. The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7, infrared device interface or wireless device interface) located at the checkout used to upload or transfer the coupon data from the coupon scanner to the retail store system (synchronization of POS and handheld device) and wherein the cradle is an infrared transceiver device interface or wireless device interface. In other words, a wireless connection (wireless communication network) is used during the synchronization process between the coupon scanner or the handheld device and the retail store POS system to transfer coupon data related to at least one electronic coupon or negotiable economic credit from the coupon scanner to the retail store POS system (Col. 4: 64 to col. 5: 24; See claims 1, 8 and 22 of the current reference), (Col. 4: 64 to col. 5: 24; col. 7: 48 to col. 8: 24; col. 8: 66 to col. 9: 34) and (col. 8: 66 to col. 9: 34).

As per claim 31, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle (docking station 22 of figs. 1, 6 and 7). The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. The coupon scanner further contains routines or a coupon management program (coupon management module) within its memory or database for managing the storage and usage of the electronic coupon data within the memory of the coupon scanner or handheld device (col. 5: 25-36; col. 8: 15-65; col. 9: 33-34).

Claims 20, 21, 22, 23, 24, 27, 28, 29 and 30 contain limitations already addressed in claims 1, 2, 3, 4, 5, 8, 9, 10 and 11 respectively and therefore, these limitations of claims 20, 21, 22, 23, 24, 27, 28, 29 and 30 are rejected under a similar rationale as respectively applied to claims 1, 2, 3, 4, 5, 8, 9, 10 and 11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6-7, 15-16, 14, 33, 51-56, 58-60, 64 and 66-68 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guthrie in view of Biorge et al. (hereinafter Biorge), US Patent 5, 806, 045A.

As per claims 6-7 and 15-16, Guthrie does not expressly disclose a method and/or system for providing one new negotiable economic credit or a new coupon during a wireless connection (redemption process or synchronization or data verification or validation) between the user's coupon scanner or handheld device and the retail store POS system, wherein the data or new coupon data related to the one new negotiable economic credit are transmitted wirelessly from a coupon source related to the retail store POS and stored within the memory of the user's coupon scanner.

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However, Biorge teaches a system for providing incentive credits to a user or customer via a handheld or portable device 74 for every qualifying transaction conducted at a participating retailer or provider having a provider device 76 wherein the value of the incentive credits is contingent upon the value of a current transaction and wherein the customer's incentive credits are stored on the memory of the portable or handheld device 74 where they can be retrieved during a redemption process. At any given time subsequent to storing the incentive credits on the customer's handheld device, the customer can take the said device 74 to the same retailer or another participating retailer or provider to redeem at least a portion of the incentive credits during a second transaction or a redemption process wherein the stored incentive credits are transmitted from the customer's handheld device 74 to the retailer's or provider's POS system or base device 72 (during a synchronization process). At the conclusion of the redemption process, the redeemed incentive credits are subtracted from the stored incentive credits and the portable device 74 memory is updating accordingly (reconciliation process). Finally, during the redemption process or second transaction (synchronization process), the retailer's POS system or base device 72 transfers newly earned incentive credits to the customer's handheld device 74 based on the value of the second transaction (See abstract; col. 6: 49 to col. 7: 64; figs. 1-3).

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the teachings of Biorge into the incentive distribution system of Guthrie so as to provide a new negotiable economic credit or a new coupon or new incentive credits to a customer for conducting a business transaction at a participating retailer while redeeming an original negotiable economic credit or incentive credits or coupon stored in the customer's

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handheld device or coupon scanner, wherein the newly earned incentive credits are transmitted from the participating retailer's POS system to the customer's handheld device, using a docking station interface, an infrared transceiver interface, a wireless device interface, etc., where they are stored on permanent memory until they are retrieved and redeemed during a future transaction at a participating POS, thereby encouraging the customer to redeem his stored incentive credits more frequently and on a timely fashion by shopping at participating or associated retailers, who continue to incentivize the customer even during a redemption process, while increasing the redemption rate of the incentive credits or coupons and rendering the incentive distribution and redemption system more effective.

Furthermore, as per claims **16, 14, 33, 51-56, 58-60, 64 and 66-68**, Guthrie discloses a system for providing electronic coupons (new coupon data) or negotiable economic credits to a user over the Internet or any computer network having a server containing a central repository or database (coupon source) storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle during an interaction or synchronization between the central repository and the coupon scanner. The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. Once the user has uploaded the coupon scanner or handheld device with the desired coupon data, the user can take the coupon scanner to a retail store where he can redeem the electronic coupons at the retail store checkout through a POS cradle (docking station 22 of figs. 1, 6 and 7, infrared device interface or **wireless device** (interface or wireless network) located at the checkout used to upload or

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transfer the coupon data from the coupon scanner to the retail store system (synchronization of POS and handheld device) and wherein the cradle is an infrared transceiver device interface or wireless device interface. In other words, a wireless connection (wireless communication network) is used during the synchronization process between the coupon scanner or the handheld device and the retail store POS system to transfer coupon data related to at least one electronic coupon or negotiable economic credit from the coupon scanner to the retail store POS system (Col. 4: 64 to col. 5: 24; See claims 1, 8 and 22 of the current reference).

In short, Guthrie supports transferring a credit or coupon, stored in the memory of the customer's handheld device, from the handheld device to a store POS system to thereby perform a redemption and wherein the transferring or synchronization is conducted in a wireless mode. In addition, transferring a credit or coupon data from a portable device or client to a store POS system during a redemption process is old and well established in the industry. No further disclosure is necessary here (See the additional references cited in the conclusion section).

Finally, using a wireless personal area network (such as a Bluetooth network), a wireless telecommunications network, a Wireless Intelligent Network (WIN) or a CDMA network as opposed to a regular wireless network (such as a RF or IR) during the transfer of data (synchronization process) between the customer's handheld device and the store POS system is a matter of desires, design choice, design consideration or great convenience, which does not directly impact the utility or functionality of the system or simply the transfer of coupon data or credit information between the handheld device and the store POS system to thereby perform a redemption or provide a credit to the customer during a transaction at the POS, wherein the credit is transmitted to the handheld device for storage and later retrieval. The latter findings

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(conclusion) are well within the skills of an ordinary artisan. Further, Guthrie never limits his system to a specific wireless network. In other words, broadly interpreting the teachings of Guthrie, the use of other well known wireless networks or technologies are herein expected as would have understood one of ordinary skill in the art.

Therefore, an ordinary skilled artisan, reading or using the system of Guthrie, would have reached the above conclusion and would have been motivated at the time of the invention to consider utilizing other wireless networks to transmit coupon data or credit information between the customer's handheld device and the store POS system to thereby rendering the system more flexible by including other stores that may have installed other wireless networks at their locations instead of RF or IR to perform data transmission between the customer's handheld device and the other store POS systems.

As per claim 12, Guthrie discloses a system for providing electronic coupons or negotiable economic credits to a user over the Internet or any computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle (docking station 22 of figs. 1, 6 and 7). The stored coupon data are marked with a unique personal identifier that will electronically stamp the coupon data with the user's personal information. The coupon scanner further contains routines or a coupon management program (coupon management module) within its memory or database for managing the storage and usage of the electronic coupon data within the memory of the coupon scanner or handheld device (col. 5: 25-36; col. 8: 15-65; col. 9: 33-34).

Response To Applicant's Arguments

The Applicant's arguments as herein presented are based on the amended claims and are fully addressed in the above Office Action.

Furthermore, the amendments to claims 1 and 20, for example, require no additional rejection since the claims now recite "wherein said at least **one** negotiable economic credit comprises at least one of the following: at least one coupon, at least one financial award, at least one financial incentive or cash". Here, the Examiner has to show only one of the choices outlined in the limitation. In fact, the Examiner has shown that the prior art (Guthrie) discloses providing a coupon to the customer, wherein the coupon data are stored in the customer's handheld device memory for permanent storage and later retrieval during a redemption process (synchronization process) at a local store POS, wherein the coupon data are transferred from the handheld device to the store POS system in a wireless mode (See above rejection).

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the present Office Action, as shown above, is **has been made Final**.

Conclusion

The following references, although not officially used, are considered to be highly relevant.

US Patent 6, 332, 127 to Bandera discloses a system for providing a coupon to a customer wherein the coupon is downloaded from a web server and uploaded on the customer's PDA device for permanent storage and wherein the PDA device is wireless connected to a store POS during a redemption process (figs 9A-9B; col. 9: 49 to col. 10: 31).

US Patent 5, 870, 030 to Deluca discloses a system for providing a coupon to a customer for answering quizzes related to advertisements displayed on the customer's pager and wherein the coupon data are downloaded from a remote system and uploaded on the customer's pager memory for permanent storage and wherein the pager having a bar code related to the stored coupon is scanned during a redemption process at a POS terminal (fig. 8; col. 10: 29 to col. 11: 2; col. 12: 26-45).

US Patent 6, 332, 128 to Nicholson discloses a system for providing a multi-level discount coupons to a customer wherein the discount coupons are encoded on a RF device, such as a transponder.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 3081113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final-703-872-9327 Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

01/06/03


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